

REMARKS

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to the entry of this response, Claims 1-9 and 11-20 were pending in this application, of which Claims 1, 15, and 18 are independent. In the Office Action dated August 5, 2008, Claims 1-9 and 11-20 were rejected under 35 U.S.C. §103(a) and Claims 1, 15, and 18 were rejected under 35 U.S.C. § 112, first paragraph. Following this response, Claims 1-5, 9, and 11-20 remain in this application with Claims 6-8 being canceled without prejudice or disclaimer. Applicants hereby address the Examiner's rejections in turn.

I. Interview Summary

Applicants thank Examiner Hassan and Senior Examiner for the courtesy of a telephone interview on October 6, 2008. During the interview, Applicants asserted that the cited references do not render obvious the claims as amended. The Examiner stated that a further search would be required. No agreement was reached regarding patentability.

II. Rejection of Claims 1, 15, and 18 Under 35 U.S.C. § 112, First Paragraph

In the Office Action dated August 5, 2008, the Examiner objected to Claims 1, 15, and 18 as failing to comply with the enablement requirement. Claims 1, 15, and 18 have been amended, and Applicants respectfully submit that these amendments

overcome this rejection. Consequently, Applicants respectfully request withdrawal of this rejection of Claims 1, 15, and 18.

III. Rejection of Claims 1-2, 4-10, 12-21, and 23-24 Under U.S.C. § 103(a)

In the Final Office Action, the Examiner rejected Claims 1-4 and 15-16 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,365,461 ("*Stein*") in view of "Tracking Menus" by George Fitzmaurice, et al. ("*Fitzmaurice*"). In addition, the Examiner rejected Claims 5-14 and 17-20 as being unpatentable over *Stein* in view of *Fitzmaurice* and U.S. Patent No. 5,133,076 ("*Hawkins*"). Claims 1 and 15 have been amended, and Applicants respectfully submit that the amendments overcome this rejection and add no new matter. With respect to Claim 18, Applicants respectfully traverse this rejection.

Amended Claim 1 is patentably distinguishable over the cited art for at least the reason that it recites, for example, "receiving a selection of the pen-based input mode button from the selection-based input device," "latching the selection-based input device, in response to receiving the selection of the pen-based input mode button, and actuating the pen-based input mode for the selection -based input device," "while the pen-based input mode is actuated for the selection-based input device, detecting a pen-based input from the pen-based input device," and "unlatching the selection-based input device, in response to detecting the pen-based input from the pen-based input device, and actuating the pen-based input mode for the pen-based input device." Claims 15

and 18 each includes a similar recitation. Support for these amendments can be found in the specification at least on page 9, lines 16-26.

In contrast, and as stated by the Examiner, *Stein* as modified by *Fitzmaurice* does not disclose latching functionality between a pen-based and a selection-based input device. (See Office Action, page 8, lines 1-3.) Consequently, *Stein* and *Fitzmaurice* cannot disclose latching a selection-based device into a pen-based input mode.

Furthermore, *Hawkins* does not overcome *Stein*'s and *Fitzmaurice*'s deficiencies. For example, *Hawkins* merely discloses that an electric stylus may be used with the screen to enter data into the computer through handwriting recognition, through form selection, or via a keyboard emulated by a portion of the screen itself and operated by the stylus. (See col. 1, line 65 - col. 2, line 2.) In *Hawkins*, the stylus emulates a mouse when used to interact with an application program graphics and is used to enter keystroke data by touching the display on the bottom segment. (See col. 9, lines 49-53.) The Examiner states that *Hawkins* teaches latching the selection-based input device so that the selection-based input device behaves as a pen-based input device at col. 3, lines 31-39 and lines 45-47. (See Office Action, page 8, lines 5-8.) However, that section of *Hawkins* merely discloses the hardware description of a computer having a display and a stylus. (See col. 3, lines 31-47.) Nowhere does *Hawkins* disclose even the presence of a separate selection-based input device, nor does *Hawkins* disclose latching such a selection-based input device for use as a pen style input device. Rather, *Hawkins* merely discloses a stylus operative as an interactive pointer interface.

Combining *Stein* with *Fitzmaurice* and *Hawkins* would not have led to the claimed invention because *Stein*, *Fitzmaurice*, and *Hawkins*, either individually or in combination, at least do not disclose "receiving a selection of the pen-based input mode button from the selection-based input device," "latching the selection-based input device, in response to receiving the selection of the pen-based input mode button, and actuating the pen-based input mode for the selection -based input device," "while the pen-based input mode is actuated for the selection-based input device, detecting a pen-based input from the pen-based input device," and "unlatching the selection-based input device, in response to detecting the pen-based input from the pen-based input device, and actuating the pen-based input mode for the pen-based input device," as recited by amended Claim 1. Claims 15 and 18 each includes a similar recitation. Accordingly, independent Claims 1, 15, and 18 each patentably distinguishes the present invention over the cited art, and Applicants respectfully request withdrawal of these rejections of Claims 1, 15, and 18.

Dependant Claims 2-5, 9, 11-14, 16-17, and 19-20 are also allowable at least for the reasons described above regarding independent Claims 1, 15, and 18, and by virtue of their dependency upon independent Claims 1, 15, and 18. Accordingly, Applicants respectfully request withdrawal of these rejections of dependent Claims 2-5, 11-14, 16-17, and 19-20.

IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 13-2725.

Respectfully submitted,
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